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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Venegas, Jr.

Serial No.: 09/597,318 Group No.: 3635

Filed: June 19, 2000 Examiner: W. Yip

For: STANCHION SLEEVE AND METHOD OF USING SAME (As Amended)

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed December 3, 2002, the Examiner's attention is directed to the following remarks.

The claims of this application are being resubmitted in unamended form on the grounds that the Examiner has failed to establish anticipation or *prima facie* obviousness.

Claims 1-6 stand rejected under the judicially created doctrine of obviousness-type double-patenting over claims 1, 4-5, 14 and 17 of U.S. Patent No. 5,2353,583 [sic]. Applicant will consider this rejection once the Examiner provides the correct patent number.

Claims 1-7 stand rejected under 35 U.S.C. §102(b) over Deike ('977). Claims 3 and 7 stand rejected under 35 U.S.C. §102(b) by Voegeli ('297). It is well settled that, in order to anticipate, a single prior-art reference must disclose *each and every element* of an invention as claimed. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In this case, closer inspection will reveal that neither Deike nor Voegeli could possibly anticipate the claims in question. Note, for example, that the preamble of claim 1 includes the language "consisting essentially of."

Claims 1-6 stand rejected under 35 U.S.C. §103(a) over Almond in view of Arth, Jr. The Examiner concedes that Almond does not define a closed end having a generally hemispherically shaped top, but that it would be obvious to combine Almond with Arth, Jr. Applicant respectfully disagrees. As a justification for the proposed combination, the Examiner states that use of a hemispherical top is "an obvious matte r of design choice ... to accommodate the shape of the stanchion

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to be received for various applications." There is no support for the argument *from the prior art.* Indeed, there is no teaching or suggestion whatsoever to combine these references, and, in fact, given that the purpose of Almond is to provide a cap which seats against a flattened stake, a flat top as opposed to a hemispherical top would be clearly more appropriate to one of skill in the art.

Claims 1-6 stand rejected under 35 U.S.C. §103(a) over Beatty in view of Arth, Jr. The Examiner concedes that Beatty does not disclose a hemispherical top, but again argues that it would have been obvious to combine Beatty with Arth, Jr. "as an obvious matter of design choice." Given that Beatty is intended to utilize a top which is conformal to flat cuts made at the top of a post, there is nothing obvious about the conversion of a flat top to a hemispherical top, since there are no hemispherically-topped posts disclosed in the '756 patent. Accordingly, *prima facie* obviousness is expressly precluded.

As a final note, the Examiner states that claims 1-6 stand rejected under 35 U.S.C. §102/§103 "for the same reasons set forth above ... since applicant does not provide any response thereto." Given that this is a request for continued examination (RCE) including a preliminary amendment, Applicant never had the opportunity until now to present any arguments with respect to these rejections. With regard to the rejection of claim 5 under 35 U.S.C. §112, second paragraph, although the cited language appears to include a negative limitation, such limitations are generally acceptable if there is a bona fide effort to recite a claim element in distinguishing fashion over potential prior art. In this case, Applicant feels the language is acceptable and appropriate.

Based upon the foregoing, Applicant believes all claims are in condition for allowance. Questions regarding this application may be directed to the undersigned attorney at the telephone/ facsimile numbers provided.

Respectfully submitted,

By: _____

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